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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/877,600	06/08/2001	Thomas J. Kennedy III	P-5550-1-C1	2472

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EXAMINER

GORDON, RAEANN

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 11/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

SM.

Office Action Summary

Application No.

09/877,600

Applicant(s)

KENNEDY ET AL.

Examiner

Raeann Gorden

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 42, and 45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Article claims cannot depend from process claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Newcomb (4,695,055). Newcomb discloses a golf ball formed from reaction injection molding (column 1, lines 36-40). The ball structure includes a homogeneous translucent plastic and a light stick inserted therein to make the golf ball multiple pieces. Note column 1, lines 55-57 which teach a polyurethane material for forming the ball.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12, 15-17, 20-33, 35-43 and 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu '673 in view of Newcomb. Wu discloses polyurethane golf ball parts (core or cover). Regarding claims 2, 3, 17, the polyurethane is a reaction product of a prepolymer and a curing agent. The prepolymer may include polyester or polyether. Regarding claims 31-33, the cover composition may further include zinc oxide, zinc sulfite, UV stabilizers, and/or optical brighteners. Regarding claim 9, the golf ball is about 1.68 inches and the cover is dimpled. Regarding claims 20, 21, the final golf ball may be painted (coating) and have nameplating (indicia). Wu does not disclose the polyurethane applied by reaction injection molding (RIM). Newcomb renders it obvious to mold the polyurethane layers of the primary reference golf ball by a reaction injection molding process, since such is an obvious expedient for providing the desired resiliency in a golf ball. Regarding claims 4-7, the particular details for the recited method are deemed conventional molding techniques that would necessarily be used in such molding process. Regarding claims 10, 11, 24-29, any other possible distinctions over the modified golf ball have been determined to be obvious lacking a showing of their criticality by a new and unexpected result. See *In re Aller et al.* 105 USPQ 233. It would have been obvious to one of ordinary skill in the art to form the golf ball of Wu '673 utilizing the reaction injection molding method detailed by Newcomb and according to the instantly claimed numbers as the applicant has not shown that these

particular numbers solve any stated purpose and it appears that the combination of Wu in view of Newcomb would accomplish similar purposes.

Claims 13, 14, 18, 19, 41, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wu '673 in view of Newcomb as applied to claims 1-12, 15-17, 20-33, 35-43 and 45-48 above, and further in view of Bayer - RIM Part and Mold Design (polyurethanes). Bayer teaches the use of glycolysis, a new way to convert polyurethane materials back to their original raw materials (page 43). One skilled in the art would have modified the invention of Wu in view of Newcomb by adding recycled material to decrease manufacturing costs.

Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wu '673 in view of Newcomb as applied to claims 1-12, 15-17, 20-33, 35-43 and 45-48 above, and further in view of Molitor '751. Wu '673 in view of Newcomb does not disclose an ionomer blended with the polyurethane in the cover material. However, Molitor teaches a cover made from a urethane and an ionomer. One skilled in the art would have modified the cover by including an ionomer to improve the durability of the cover.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefore ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

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40,41, 43,

Claims 16-21, 23, 25, 29-36, 38-41, 43, 44, and 48 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 14-20, 22, 27-32, 34-41, and 44 of copending Application No. 09/040,798. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-15, 22, 24, 26-28, 37, 42, and 45-47 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13, 21, 23-26, 33, 42, and 43 of copending Application No. 09/040,798. Although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention and the '798 application both claim the process of making a golf ball comprising making at least a core and a cover component by mixing two or more reactants. The '798 application produces a product with a flex modulus from 5 to 310 kpsi in a reaction time of 5 minutes or less. The present invention produces a product with a flex modulus from 1 to 310 kpsi in a reaction time of less than 2 minutes. Varying the reaction time of the product is an obvious modification of the '798 application that would promote the desired and/or

optimal characteristics of the product.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

Applicant's arguments filed 9-12-02 have been fully considered but they are not persuasive. Applicant argues the article claims may depend from process claims and cites several issued patents. Since applicant has admitted that the article claims in the present invention are dependent on the independent process claims the rejection is maintained. Applicant is required to write an independent claim for the golf ball or cancel the claims. Applicant further argues the rejection of claim 16 over Newcomb. Applicant claims a multi-piece golf ball and states the Newcomb reference does not consist of a more than one layer as defined. Although, Newcomb discloses a solid piece with an inserted stick, it is considered a layer. Applicant does not limit the shape or size of any of the layer of the multi-piece golf ball. Applicant also argues the combination of Wu and Newcomb and states that one skilled in the art would not be led to make the golf ball disclosed by Wu with the method taught by Newcomb. The Examiner disagrees. The primary reference is cited to teach the ingredients of the polyurethane layer as claimed by applicant. The Newcomb reference is used as a secondary reference to show RIM process is commonly used in the golfing art and is not new or innovative. Although, Newcomb does not give details regarding the steps in the process applicant has not shown how the RIM process taught by Newcomb differs

from the RIM process claimed by applicant. Since applicant has not addressed the double patenting issues the rejection is maintained.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raeann Gorden whose telephone number is 703-308-8354. The examiner can normally be reached on 7:30 AM to 5:00 PM Mon-Fri.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Sewell can be reached on 703-308-2126. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-308-3579 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

RG
November 13, 2002



Mark S. Graham
Primary Examiner